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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,261	10/22/2003	Ian D. Gaston	2560.054 (50-02-059CP)	5449
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DOCKET CLERK P.O. BOX 12608 DALLAS, TX 75225			EXAMINER CARTER, CANDICE D	
			ART UNIT 3629	PAPER NUMBER
			NOTIFICATION DATE 04/28/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket.clerk@kelly-krause.com

Office Action Summary

Application No.

10/691,261

Applicant(s)

GASTON ET AL.

Examiner

CANDICE D. CARTER

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. The Following is a Final Office Action in response to communications received on February 9, 2009. Claims 1, 4-7, 9-12, 14, and 15 have been amended. No claims have been cancelled. No new claims have been added. Therefore, claims 1-15 are pending and have been addressed below.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

Claims 1-5 are directed towards a method for standardizing reporting of issues consisting of process steps that may be performed by a series of mental steps.

Examiner contends that a process must be (1) tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing.

An applicant may show that a process claim satisfies 35 U.S.C. § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the

machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See *Flook*, 437 U.S. at 590. *In re Bilski*.

In the instant case, the computer system is not recited as actually performing the method steps of the claim. Therefore, the method steps are not sufficiently tied to a particular machine and, as such, the method is not considered to be a statutory method.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, and 5-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falso et al. (2003/0125965) Wolff et al. (5,774,887) and further in view of Hitchcock et al. (6,4460,042).

As per claim 1, Falso et al. discloses "A method for standardizing reporting of issues, assumptions, and risks for a risk review board, the method comprising:

presenting with a form for entering information about a risk management unit; receiving the information about the risk management unit" (§ 27 and Fig. 2 disclose a display page used to collect information about a risk management contract, where the display page presents a form for entering the information);

"providing to a user a form with entry areas for every element needed to properly adhere to a risk management scheme" (Fig. 2 displays entry fields for elements needed for the risk management contract).

"entering information needed to properly adhere to a risk management scheme, the information including at least a name of a risk owner, an explanation of how the risk came about, a driver of the risk, a milestone of the risk, the last possible start date for action to take place to avoid the impact of the risk, the criticality of the risk, the controllability of the risk, what actions have been taken to-date with respect to the risk, one or more actions that have been identified to prevent the risk from occurring, and the cost of any action" (§§ 34 and 35 disclose name fields and positions fields for identifying the name and organizational position of the person with responsibility for the selected contract, where the individual responsible for the contract is the individual that is responsible for the risks associated with the contract [risk owner])

Falso et al., however, fails to explicitly disclose "hindering the user from exiting the form prior to supplying appropriate information necessary for adherence to the risk management scheme".

Wolff et al. discloses a customer service electronic form generating system "hindering the user from exiting the form prior to supplying all information" (col. 8, line 26-40 discloses that the system determines whether the form is complete before the user can exit from the existing form into the next uncompleted form).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method for managing contractual risk of Falso et al. to include the hindering of a user from exiting a form as taught by Wolff et al. in order ensure that a user has entered all pertinent information before exiting the form.

Hitchcock et al. discloses a universal forms engine that checks to make sure that appropriate information is supplied to the forms (col. 14, line 63-col. 15, line 5 discloses data validation that checks the validity of the information that is in the fields of the form, where checking the validity is checking that the information is valid and appropriate for the particular fields being used).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method for managing contractual risk of Falso et al. to include checking the validity/appropriateness of the data in the fields of the form as taught by Hitchcock in order to ensure that all data meets the criteria of the data that is requested by the specific form fields.

Claims 6 and 11 recite equivalent limitations to claim 1 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 2, Falso et al. further discloses "generating a report in a standardized format based on the information about the risk" (§ 21 discloses generating a risk report which includes the information about the risk contract and Fig. 5 displays a sample risk report that is generated in a standardized format).

Claims 7 and 12 recite equivalent limitations to claim 2 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 3, Falso et al. discloses "the risk management unit is one of an assumption, a risk, an issue, and a risk plan" (§ 2 discloses a risk of not meeting a delivery deadline).

Claims 8 and 13 recite equivalent limitations to claim 3 and are, therefore, rejected using the same art and rationale as set forth above.

As per claim 5, Falso et al. discloses all of the elements of the claimed invention but fails to explicitly disclose "the step of wherein the user is hindered from exiting the form prior to supplying appropriate information necessary for adherence to the risk management scheme comprises preventing the user from exiting an entry field until the user has provided an entry for the entry field".

Wolff et al. discloses a customer service electronic form generating system "preventing the user from exiting an entry field until the user has provided an entry for the entry field" (col. 9, line 37-47 discloses that the system determines whether the customer service representative has completed the current field before allowing the customer to move onto the next fields).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for managing contractual risk of Falso et al. to include the step of hindering a user from exiting a field before completing it as taught by Wolff et al. in order to ensure that a user has entered all pertinent information before exiting the field.

Hitchcock et al. discloses a universal forms engine that checks to make sure that appropriate information is supplied to the forms (col. 14, line 63-col. 15, line 5 discloses data validation that checks the validity of the information that is in the fields of the form, where checking the validity is checking that the information is valid and appropriate for the particular fields being used).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method for managing contractual risk of Falso et al. to include checking the validity/appropriateness of the data in the fields of the form as taught by Hitchcock in order to ensure that all data meets the criteria of the data that is requested by the specific form fields.

Claims 10 and 15 recite equivalent limitations to claim 5 and are, therefore, rejected using the same art and rationale as set forth above.

6. Claims 4, 9, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Falso et al. in view of Wolff et al. in view of Hitchcock and further in view of Engert et al. (1999).

As per claim 4, Falso et al. further discloses a risk management scheme (¶ 19 discloses a system for managing risk factors, where this system is a risk management scheme).

Falso, however, fails to explicitly disclose an ABCD risk management scheme, wherein at least one of the letters of "A", "B", "C", and "D" are ascribed to a determined level of risk.

Engert et al. discloses a risk matrix user's guide having a risk management scheme that ascribes letters to a determined level of risk (see page 16).

Therefore, it would have been obvious to one of ordinary skill in the pertinent art at the time the invention was made to modify the method and system for managing contractual risk of the Falso et al., Wolff et al., and Hitchcock et al. combination to

include a risk management scheme ascribing letters to a determined level of risk as taught by Engert in order to easily measure/identify risk type and severity.

Furthermore, Examiner considers the specific characters/letters that are ascribed to be nonfunctional. The specific letters, characters, or notations being used to identify risk levels does not change the function of the claimed invention.

Claims 9 and 14 recites equivalent limitations to claim 4 and are, therefore, rejected using the same art and rationale as set forth above.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 6, and 11 have been considered but are moot in view of the new ground(s) of rejection.

In response to arguments in reference to claims 2-5, 7-10, and 12-15, all rejections made towards the dependent claims are maintained due to a lack of reply by the applicant in regards to distinctly and specifically pointing out the supposed errors in the examiner's prior office action (37 CFR 1.111). The Examiner asserts that the applicant only argues that the dependent claims should be allowable because the independent claims are unobvious and patentable over the prior art.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CANDICE D. CARTER whose telephone number is (571) 270-5105. The examiner can normally be reached on Monday thru Thursday 7:30am- 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. D. C./
Examiner, Art Unit 3629

/JOHN G WEISS/
Supervisory Patent Examiner, Art Unit 3629